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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,072	10/23/2001	Horst Cirzonka	BW-419-2	9406

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EXAMINER

WALLS, DIONNE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,072

Applicant(s)

GRZONKA ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26, 28, 30, 32 and 33 is/are allowed.
- 6) ☒ Claim(s) 11-15, 17-22, 27, 29 and 31 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the Written Restriction in Paper No. 6 is acknowledged.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the title is not on the declaration.

Claim Objections

3. Claims 16 and 22 are objected to because of the following informalities:
 - In claim 16, line 3, "inserting" should be changed to – inserted --,
 - In claim 22, line 2, "using" should be changed to – by --.

Appropriate correction is requested.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The claims below are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 11 recites the limitation "the rod" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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7. Claim 18 recites the limitation "the application body" in line 2, and "the circumference" in line 3. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 21 recites the limitation "the hollow mandrel" in line 2. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 27 recites the limitation "said carrier drum" and "said application body" in line 2. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 29 recites the limitation "said application body" in line 2. There is insufficient antecedent basis for this limitation in the claim.
11. Claim 31 recites the limitation "said auto-rotation" in line 1. There is insufficient antecedent basis for this limitation in the claim.
12. Claims 17, 26, 30, 32, and 33 recite the limitation "screw-like", which renders the scope of the term unascertainable since it is not clear what the term "-like" encompasses. Examiner suggests that this term simply be deleted from the claims.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman (US. Pat. No. 3,545,453).

Hoffman discloses all that is recited in the claims (see entire document; and specifically fig. 6). While the fluted cylinder 26 (corresponding to the claimed "drum (1)") may not be specifically cited as that used in a cigarette machine or a filter assembler, the structure of said cylinder is such that it is inherently capable of use in such a machine/assembler. Where the claimed and prior art product/apparatus is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (US. Pat. No. 3,545,453).

While the Hoffman reference may not specifically disclose the use of a pump in which to supply the flowable medium to the needle 56 (corresponding to the claimed "hollow mandrel"), it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize such since pumps are well-known for their use in facilitating the dispensing of liquid.

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17. Claims 17-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman (US. Pat. No. 3,545,453) in view of Alm (US. Pat. No. 2,250,452).

While Hoffman may not specifically articulate a rotating means to provide the needle with auto-rotation when feeding flowable medium, said needle having screw-like outer grooves, Alm discloses that it is known to pierce cigars by reciprocating or rotary needles (see page 1, lines 10-15). While this procedure may be described for the purpose of providing an air-draft in said cigar, one having ordinary skill in the art would have obviously been motivated to provide the needle of Hoffman with rotary movement in order to facilitate the insertion of the needle into the end of the cigar. While Hoffman modified by Alm may not teach that the needles are provided with screw-like grooves, Alm does disclose that the needles utilized in its invention to pierce the cigars are actually drills that have sharpened cutting edges. Further, its known in many art to provide drills with "screw-like grooves" in order to facilitate the insertion of the drill into its receiver. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide "screw-like grooves" on the needle of Hoffman modified by Alm for this purpose.

Regarding claim 18, Alm discloses how the hollow drills of its invention are mounted to enable rotation (see page 2, col. 1, lines 55-67), which – the Examiner believes – corresponds to the limitations of this claim.

18. Claims 11-15, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanki et al (US. Pat. No. 3,837,378).

Kanki discloses all that is recited in the claims (see entire document; specifically figs. 1-3 and 8) except it may not specifically state that its device is used for supplying a flowable medium to the tobacco rod of a smoking product. However, claims directed to apparatus must be distinguished from the prior art in terms of *structure* rather than *function*. (Emphasis added) *In re Danly*, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Also, a claim containing recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. See MPEP 2114.

Allowable Subject Matter

19. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. Claims 26, 28, 30, 32 and 33 are allowed.

21. Claims 27, 29, and 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

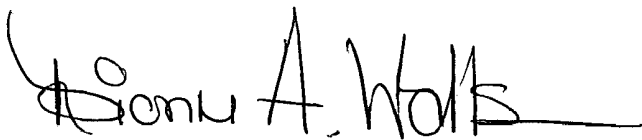
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- Lakritz (US. Pat. No. 3,732,872)
- Seil (US. Pat. No. 3,847,162)
- Keritsis et al (US. Pat. No. 4,966,170)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", with a horizontal line extending to the right.

Dionne A. Walls
May 16, 2003